

Appl. No. 10/027,751
Resp./Amdt. dated May 16, 2005
Reply to Office Action of 02/24/2005

REMARKS/ARGUMENTS

There are no amendments to the specification, claims or drawings herein.

In the Claims, Claims 1-32 are pending. Claims 16-26 were allowed. Claims 1, 2, 27 and 29 were rejected and Claims 3-15, 28 and 30-32 were objected to. Reconsideration is respectfully requested.

The Examiner rejected Claims 1, 2, 27 and 29 under 35 U.S.C. 102(e) as being anticipated by McCallister et al., U.S. Pat. No. 6,507,628 (hereinafter 'McCallister et al.'). The rejection of Claims 1, 2, 27 and 29 under 102(e) in view of McCallister et al. constitute new grounds for rejection.

Applicant traverses the rejection of Claim 1, 2, 27 and 29 on the grounds that the Examiner failed to establish a *prima facie* case of anticipation with respect to McCallister et al. In particular, Applicant submits that McCallister et al. do not disclose, explicitly or implicitly, "each element of the claim under consideration" (*W.L. Gore & Associates v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)) and/or do not disclose the claimed elements "arranged as in the claim" (*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)), as required by the Federal Circuit for *prima facie* anticipation under 35 USC 102.

In particular regarding Claim 1, the Examiner contended "McCallister (USPN 6,507,628) teaches a method of extending dynamic range of a test, [*sic*] system that has a receiver channel comprising: compensating for an effect that compression of the receiver channel has on as [*sic*] magnitude response and a phase response of the receiver channel". In support of the contention, the Examiner cited Col. 9, lines 53-55.

Contrary to that contended by the Examiner, McCallister et al. do not disclose or even suggest that claimed by Applicant in Claim 1. Instead, McCallister et al. generally disclose a distortion-compensated digital communication receiver and method therefor. In particular, McCallister et al. disclose, "[t]he receiver (30) includes a magnitude adjuster (80) which increases the magnitude component of selected phase estimates to at least partially compensate for the compression distortion" (McCallister et al., Abstract, lines 5-9). The disclosed compression distortion is introduced by "compressor 50" of a "digital communications transmitter

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30", according to McCallister et al. (see McCallister et al., FIG. 2, Col. 5, line 27, and Col. 3, lines 39-40). At Col. 5, lines 27-31, McCallister et al. clearly disclose, "[c]ompressor 50 compresses the amplitude of the communication signal defined by the data stream from pulse shaper 44. Desirably, compressor 50 performs its amplitude compression in a manner that substantially prevents spectral expansion."

Further, a "digital communications receiver 60" is illustrated in FIG. 3 and described beginning at Col. 5, line 57 by McCallister et al. Regarding the 'digital communications receiver 60', at Col. 7, lines 53-55, McCallister et al. disclose, "[m]agnitude adjuster 80 [of the disclosed digital communications receiver 60] is provided to compensate, to some degree, for the system-induced distortion imposed by the operation of compressor 50 (FIG. 2)".

In contrast, Applicant's Claim 1 recites a "method of extending dynamic range of a test system comprising: compensating for an effect that compression of the receiver channel has on a magnitude response and a phase response of the receiver channel". Applicant respectfully finds no similarity between that disclosed by McCallister et al. and that recited in Applicant's Claim 1. In particular, neither at Col. 9, lines 53-55, relied upon by the Examiner, nor anywhere else therein for that matter, do McCallister et al. disclose "compensating for an effect that *compression of the receiver channel* has on a magnitude response and a phase response of the receiver channel", as recited in Applicant's Claim 1 (*emphasis added*).

Instead, the *only* references to 'compression' in the teachings of McCallister et al. are associated with the action of the 'compressor 50' which is explicitly a part of the 'digital communications *transmitter* 30' and *not a receiver channel*. Moreover, the only disclosures regarding 'compensating' by McCallister et al. relate entirely to an action or operation of the 'magnitude adjuster 80' which, in turn, explicitly compensates for "system-induced distortion [amplitude compression] imposed by the operation of compressor 50" (McCallister et al., Col. 7, lines 54-55). McCallister et al. never disclose "compression of the receiver channel" and never disclose, or even suggest, 'compensating therefor'. In fact, McCallister et al. never mention or allude to compression of a receiver channel or an effect of compression on a receiver channel. In the absence of a disclosure regarding *receiver channel compression* and compensating for the effects thereof, McCallister et al. respectfully cannot disclose that recited in Applicant's Claim 1. For that matter, McCallister et al. do not disclose,

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or even suggest, a method of extending dynamic range of a test system. Thus, McCallister et al. do not and cannot disclose each element of Applicant's Claim 1, contrary to the Examiner's contention.

Regarding Claim 27, the Examiner relied on Col. 9, lines 17-18, of McCallister et al. to contend anticipation of "a computer program ... that compensate for an effect on the generated data caused by the receiver channel being compressed", as recited in Applicant's Claim 27. However, McCallister et al. fail to disclose that claimed by Applicant in Claim 27, contrary to that contended by the Examiner.

In particular, neither at Col. 9, lines 17-18, relied upon by the Examiner, nor anywhere else in the teachings of McCallister et al. is there a disclosure relating to "the receiver channel being compressed", as recited in Applicant's Claim 27. Moreover, as discussed hereinabove with respect to Claim 1, McCallister et al. never disclose an effect of receiver channel compression or compensating therefor. McCallister et al. simply do not and cannot disclose or suggest that recited in Applicant's Claim 27, contrary to the Examiner's contention.

Regarding Claims 2 and 29, the Examiner contended "McCallister (USPN 6,507,628) teaches compensating comprises correcting data measured for one of a device under test and a signal under test using the test system". The Examiner cited Col. 9, lines 53-55 and the abstract, in support of the contention.

Contrary to the Examiner's contention, McCallister et al. fail to disclose that recited in either of Applicant's Claim 2 or Claim 29. For example, McCallister et al. do not disclose any of a "test system", "device under test", or a "signal under test", as defined by Applicant and recited in Applicant's Claim 2. Regarding Applicant's Claim 29, McCallister et al. never disclose either a "network analyzer" or a "spectrum analyzer". Moreover, Claim 2 is dependent from and includes all of the limitations of independent Claim 1 while Claim 29 dependent from and includes all of the limitations of independent Claim 27. Since McCallister et al. never disclose that recited in Applicant's Claims 1 and 27, then McCallister et al. cannot disclose that recited in Applicant's Claims 2 and 29.

Therefore, Applicant respectfully submits that the Examiner failed to establish separately for each of Claims 1, 2, 27 and 29, a *prima facie* case of anticipation of with respect to McCallister et al. In particular, the Examiner failed to show that there is "no difference between the claimed invention and the reference disclosure, as

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viewed by a person of ordinary skill in the field of the invention" as required by the Federal Circuit. *Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991). Hence, the rejection of Claims 1, 2, 27 and 29 under 35 U.S.C. 102(e) is unsupported by facts in evidence and must be withdrawn for at least the reasons set forth hereinabove.

Applicant appreciates the Examiner's recognition of the allowability of Claims 16-26. Applicant further appreciates the Examiner's recognition that Claims 3-15, 28 and 30-32 would be allowable if rewritten in independent form. However, in view of Applicant's arguments hereinabove with respect to the rejections of at least base Claims 1 and 27, Applicant respectfully declines to amend Claims 3-15, 28 and 30-32 at this time. Reconsideration is respectfully requested.

In summary, Claims 1-32 are pending. Claims 16-26 were allowed. Claims 1, 2, 27 and 29 were rejected and Claims 3-15, 28 and 30-32 were objected to. For the reasons detailed above, rejected Claims 1, 2, 27 and 29 and objected to Claims 3-15, 28 and 30-32 are in condition for allowance. It is respectfully requested that Claims 1-15 and 27-32 be allowed along with allowed Claims 16-26, and that the application be passed to issue at an early date.

Should the Examiner have any questions regarding the above, the Examiner is urged to contact the undersigned by telephone at the number given below, or John L. Imperato, Attorney for Applicant, Registration No. 40,026 at Agilent Technologies, Inc., telephone number (650) 485-5511.

Respectfully submitted,
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CERTIFICATE OF TRANSMISSION

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5/16/05
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